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10/612,238	07/02/2003	Tetsujiro Kondo	450100-04655	4979
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William S. Frommer, Esq. FROMMER LAWRENCE & HAUG LLP 745 Fifth Avenue New York, NY 10151				
EXAMINER				
YENKE, BRIAN P				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/612,238

**Applicant(s)**

KONDO ET AL.

**Examiner**

BRIAN P. YENKE

**Art Unit**

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on RCE/Amendment (05/12/08).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4 and 6-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) all the above is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to the claims have been considered but are not persuasive, see rejection pertaining to the newly added/argued limitations below.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Section IV.C, reads as follows:

While abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be. In evaluating whether a claim meets the requirements of section 101, the claims must be considered as a whole to determine whether it is for a particular application of an abstract idea, natural phenomenon, or law of nature, rather than for the abstract idea, natural phenomenon, or law of nature itself.

For claims including such excluded subject matter to be eligible, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. Diehr, 450 U.S. at 187, 209 USPQ at 8 ("application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection."); Benson, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it "has no substantial practical application").

To satisfy section 101 requirements, the claim must be for a practical application of the Sec 101 judicial exception, which can be identified in various ways:

The claimed invention "transforms" an article or physical object to a different state or thing.

The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

Claims 1-2, 4 and 6-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 1-2, 4, 6-18 recites functional descriptive material on a computer readable medium/information processing apparatus. However, the program/algorithm itself merely manipulates data or an abstract idea, or merely solves a mathematical problem without a limitation to practical application. A practical application exists if the result of the claimed invention is "useful, concrete and tangible" (with the emphasis on "result") (Guidelines, section IV.C.2.b). A "useful" result is one that satisfies the utility requirement of section 101, a "concrete" result is one that is "repeatable" or "predictable", and a "tangible" results is one that is "real", or "real-world", as opposed to abstract (Guidelines, section IV.C.2.b)). Claims 1-2, 4 and 6-18 merely manipulate data without ever producing a useful, concrete and tangible results.

In order for the claimed product to produce a "useful, concrete and tangible" result, recitation of one or more of the following elements is suggested:

- The manipulation of data that represents a physical object or activity transformed from outside the computer.
- A physical transformation outside the computer, for example in the form of pre or post computer processing activity.
- A direct recitation of a practical application;

Applicant is also advised to provide a written explanation of how and why the claimed invention (either as currently recited or as amended) produces a useful, concrete and tangible result.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

Art Unit: 2622

patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4, and 6-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuen, US 7,003,792.

In considering claims 1 and 16-18

a) the claimed processing means for processing the content data is met by Yuen which includes a video source and a source of advertisements which are processed in accordance with a user's viewing habit/profile.

b) the claimed acquisition means...is met where the system uses a smart agent (SA) which collects information of a user to infer user's preferences and accordingly determine a user profile, which is based on the user's input/history.

c)-d) the claimed generation means...is met where based upon the content data (video and advertisement) in accordance with the user information, determines the selection/filtering of such information to the user (col 53-67), wherein a user profile is generated based upon psych—demographic data (5), users selection (2), statistical data (4) which are integrated/modeled/weighted to obtain such profile (6) (see Fig 1a and related description).

f) the claimed the value of the second weight...Yuen discloses (eq shown in claim 7) that certain events can give weight or take away weight for a given event, which is based in part on user's selection(s).

However, Yuen does not explicitly disclose the increasing resolution (limitation a) nor generating the second information by performing the weighting such that a greatest weights is applied to the median of the first information, not the value of the first weight being cumulative as claimed (limitation e).

The concept of increasing the resolution of data is notoriously well known in the art, for the obvious result of obtaining a better picture thus the examiner takes "OFFICIAL NOTICE" regarding such.

In the event the applicant traverses such notice, the examiner notes, numerous documents cited by the applicant which also disclose this feature.

Yuen does disclose that the smart agent uses an iterative process/means to integrate the habit, statistics and psycho-demographic information, using equations which are weighted and include the use of probabilities.

It is also known that when evaluating/measuring/detecting a user's viewing habit/profile, the habit/profile would include many layers/parameters (i.e. sports, news, or time of day etc...) and these individuals parameters (e.g. time) may be weighted greater in selecting/filtering such information to the user (i.e. the claimed 2nd information).

The examiner maintains that the weighting of one or more pieces information greater in relation to other pieces of information is considered obvious to one of ordinary skill in the art since statistics/probabilities/data measurement techniques afford such uses in order to provide a user/system the ability to weight different parameters according to different weights in order to provide a desired result(s) the limitation would be obvious to one of ordinary skill in the art to implement.

In the event the applicant disagrees, the examiner would like the applicant to clarify how this feature was not possible to be carried out or unknown in the prior art in order to expedite prosecution.

Regarding the newly added first weight is cumulative and is updated by adding the second weight to the first weight each time the second weight is generated, as stated above, the weighting of data, which includes adding or taking away weights (which Yuen discloses), would be performed by Yuen since the user selection (first information for instance) would be weighted/integrated with the other data (5 and 4, Fig 1a) which generates the user profile (2<sup>nd</sup> information) wherein the first information (user selection) is weighted with data 3, 4 and 5 (Fig 1a). Thus given the broadest reasonable interpretation when the second weight (whether data 5, data 3 or data 4) is generated wherein the first weight may be the integrated data (3) which receives data's 2, 4 and 5.

It is also noted based upon the decision by the Supreme Court in KSR vs Teleflex, the premise that predictable variations, which could be performed by someone of ordinary skill in the art, would likely be barred via an obviousness (103) rejection. In the instant case the weighting of data/information as claimed, provides predictable results, and thus the 103 rejection was made. In the event the applicant disagrees and maintains that the results are not predictable the examiner requests applicant to clarify as such, and reasons stating why one of ordinary skill in the art could not implement/carry out such alleged (if applicants positively responds to such) variations, In order to expedite prosecution. The examiner's premise is the manipulation/weighting of data, whether using statistical/probability models etc...provides results which are based upon an equation(s)/algorithm(s), thereby being derived/predicted from such.

In considering claims 2-3,

Refer to claim 1 above.

In considering claim 4,

Yuen discloses a user selection via input device 44.

b) the claimed control command/data input detection...is met where the system includes a viewer input device 44 which is used by the SA to control the selection/filtering of information.

c-d) the claimed wherein the generation means...is met wherein the SA based upon the user's selection determines the information that is delivered which can be matched, filtered or selected. Thus if a user spends more time enter a certain genre of information, the SA will customize the targeting using such genre (i.e. more weight for more time). By the same token if a user does not spend any time any particular genre/program/type of material, the system will not weight this material/content as much as what a user spends time watching/entering.

In considering claim 6,

Yuen discloses that based upon a user's viewing habits/profile, will provide the user information that is matched, filtered or selected based upon such habits/profile. Thus the data/features of video/audio services will be processed and delivered or not based upon the user's profile.

In considering claim 13,

Refer to claim 1 above.

In considering claim 14,

Yuen discloses a receiver with a memory in addition to the ability to download information (col 2, line 9-22) meeting the claimed storage means.

In considering claims 7-8,

Yuen does not explicitly recite the mean/variance of image level in feature detection, although it is known that data can be analyzed in a multitude of way in order to ascertain image quality/content or change, thus the examiner takes "OFFICIAL NOTICE" regarding such.

In considering claims 9-12,

Yuen does not explicitly recite the detection of environmental information (i.e. ambient conditions). However, the concept of altering the viewing experience based upon temperature, time of day etc...are notoriously well known in the art and thus the examiner takes "OFFICIAL NOTICE" regarding such, since the inclusion of such enhances the viewing experience as previously known in the art.

In considering claim 15,

Although Yuen does not explicitly recite removable storage, Yuen does disclose a system which may operate in a computer, television environment wherein it is known to store data on a removable media, such as a CD, DVD, etc...thus the examiner takes "OFFICIAL NOTICE" regarding such, for the obvious purpose of giving the user added portability/security of such information.

***Conclusion***



Art Unit: 2622

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Yenke whose telephone number is (571)272-7359. The examiner work schedule is Monday-Thursday, 0730-1830 hrs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, David L. Ometz, can be reached at (571)272-7593.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(571)-273-8300**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703)305-HELP.

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(FAX) 703-305-7786

(TDD) 703-305-7785

An automated message system is available 7 days a week, 24 hours a day providing informational responses to frequently asked questions and the ability to order certain documents. Customer service representatives are available to answer questions, send materials or connect customers with other offices of the USPTO from 8:30 a.m. - 8:00p.m. EST/EDT, Monday-Friday excluding federal holidays.

Art Unit: 2622

For other technical patent information needs, the Patent Assistance Center can be reached through customer service representatives at the above numbers, Monday through Friday (except federal holidays) from 8:30 a.m. to 5:00 p.m. EST/EDT.

The Patent Electronic Business Center (EBC) allows USPTO customers to retrieve data, check the status of pending actions, and submit information and applications. The tools currently available in the Patent EBC are Patent Application Information Retrieval (PAIR) and the Electronic Filing System (EFS). PAIR (<http://pair.uspto.gov>) provides customers direct secure access to their own patent application status information, as well as to general patent information publicly available. EFS allows customers to electronically file patent application documents securely via the Internet. EFS is a system for submitting new utility patent applications and pre-grant publication submissions in electronic publication-ready form. EFS includes software to help customers prepare submissions in extensible Markup Language (XML) format and to assemble the various parts of the application as an electronic submission package. EFS also allows the submission of Computer Readable Format (CRF) sequence listings for pending biotechnology patent applications, which were filed in paper form.

/BRIAN P. YENKE/  
Primary Examiner, Art Unit 2622

B.P.Y  
01 July 2008

